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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/507,124	09/10/2004	Holger Blum	KIRS.0013	8900

Reed Smith
Suite 1400
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7590 07/09/2008

EXAMINER

RONESI, VICKEY M

ART UNIT	PAPER NUMBER
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1796

MAIL DATE	DELIVERY MODE
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07/09/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/507,124	Applicant(s) BLUM, HOLGER	
	Examiner VICKY RONESI	Art Unit 1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 2 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 May 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☒ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2 and 4-6 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1,2,4 and 5 is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☒ Claim(s) 6 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--------------------------------------------------------------------------------------|-------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Ex Parte Quayle

1. This application is in condition for allowance except for the following formal matters:

Specification

2. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: support is not given for claims 4-6 which recites the ranges of amounts of 0.4-4 % Component A, 0.2-2 % Component B, and 0.5-5 % for Components A and B. Also not disclosed in the specification is the total amount of aldehyde resin plus Component B based upon the total weight of the paint or paint base (claims 1, 4, and 5) or the total amount of aldehyde resin plus Component A based upon the total weight of the paint or paint base (claim 2).
3. Applicant argues that meaning of the terms (i.e., amounts in percent) in the claims are ascertainable by reference to the description. In response, the MPEP states that “[t]he meaning of every term used in any of the claims should be apparent from the descriptive portion of the specification with clear disclosure as to its import” (MPEP § 608.01(o)). The specification does not even mention amounts in terms of percent, rather, the examples are in parts by weight. For this reason, the specification does not provide proper support for the claimed subject matter.

It is noted that applicant asserts that support is provided in the initially submitted (i.e. originally filed) claims (cf. p. 8 of Remarks filed 5/27/08). That is fine but it does NOT absolve the applicant from amending the specification to support such originally filed claimed subject

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matter. Indeed amending the specification in this type of situation is a requirement as evidenced by the following quotation from MPEP 608.01(o):

"Applicant will be required to make appropriate amendment to the description to provide clear support or antecedent basis for the terms appearing in the claims provided no new matter is introduced."

Claim Objections

4. Claim 6 is objected to because of the following informalities: claim 6 is a product-by-process claim, however, the phrase "one or more auxiliary additive selected from the group consisting of pigments, antisepting agents, plasticizers, solvents, biocides, fibers, stabilizers and film consumption regulators" is not part of a step and seems to be dangling. It is suggested that a step of adding these additives is added to the claim language. Appropriate correction is required.

5. Prosecution on the merits is closed in accordance with the practice under *Ex parte Quayle*, 25 USPQ 74, 453 O.G. 213, (Comm'r Pat. 1935).

A shortened statutory period for reply to this action is set to expire **TWO MONTHS** from the mailing date of this letter.

Allowable Subject Matter

6. As allowable subject matter has been indicated, applicant's reply must either comply with all formal requirements or specifically traverse each requirement not complied with. See 37 CFR 1.111(b) and MPEP § 707.07(a).

The following is a statement of reasons for the indication of allowable subject matter: Ichikawa et al discloses a heat-sensitive layer for a printing plate comprising 1-200 parts by weight (pbw) of metal-containing organic compounds including mixtures of aluminum compounds such as aluminum di-sec-butoxide ethylacetoacetate and titanium compounds such as isopropyltri(dioctyl phosphate) titanate; and 100 pbw hydroxyl group-containing compounds such as phenolformaldehyde novolak resins (col. 8, lines 20-51); and pigments (col. 3, lines 44-65). Ichikawa et al fails to disclose or suggest the use of fibers as a reinforcing agent in the composition.

JP 08-053633 discloses an antifouling coating composition an aldehyde resin which can be combined with a soluble resin (paragraphs 0022-0024) but fails to disclose the use of the presently claimed aluminum di-secalkoxide acetoacetic ester chelate or monoalkoxy organotitanate-IV.

Conclusion

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to VICKEY RONESI whose telephone number is (571)272-2701. The examiner can normally be reached on Monday - Friday, 8:30 a.m. - 5:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on (571) 272-1119. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

7/2/2008

Vickey Ronesi

/V. R./

Examiner, Art Unit 1796

/VASUDEVAN S. JAGANNATHAN/

Supervisory Patent Examiner, Art Unit 1796